

## **REMARKS**

### **I. Introduction**

With the addition of claim 73, claims 1 to 59, 61, 62 and 64 to 73 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 49 to 54, 56 to 59, 66 and 68 to 72 Under 35 U.S.C. § 102(e)**

Claims 49 to 54, 56 to 59, 66 and 68 to 72 were finally rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,366,206 ("Ishikawa et al."). Applicant respectfully submits that Ishikawa et al. do not anticipate claims 49 to 54, 56 to 59, 66 and 68 to 72 for the following reasons.

Claim 49 relates a medical label system. Claim 49 recites that the medical label system includes at least one integrated circuit, wherein the integrated circuit uniquely identifies a medical product the label is attached to by transmitting a radio frequency identifier (RFID) for the medical product in response to an RF signal. Claim 49 has been amended to recite that medical label system includes a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track and store a location of the medical product based on the RFID. Support for this amendment can be found, for example, in the Specification at p. 21, pars. 47 and 48 and Fig. 3.

Ishikawa et al. purportedly relate to a method and apparatus for attaching tags to medical and non-medical devices. Ishikawa et al. state that transponder 15 may be used to tag any medical product or device, or non-medical products or devices. See col. 8, lines 26 to 29. Ishikawa et al. further state that before closing the patient's body at the site of the surgery, the site may be scanned with the monitoring unit 17 and that if a sponge ball transponder 15 responds the sponge may be located and removed. See col. 8, lines 32 to 35. Ishikawa et al. further state that the instruments may be scanned before surgery to generate an inventory and that at the end of the surgery the surgical suite may be scanned to account positively for all items in the inventory. See col. 8, lines 37 to 41.

Nowhere do Ishikawa et al. disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Ishikawa et al. merely disclose scanning the medical instruments before surgery to generate an inventory and scanning the entire surgical suite to account positively for all items in the inventory after the surgery.

As can be seen in Figure 3, the computer system of the present invention uses a location field 180 to track, e.g., the garbage, the main table, etc., of the medical product in question, not just to account for all medical product in inventory at the end of the surgical procedure as Ishikawa et al. disclose.

The Final Office Action points to col. 8, lines 26 to 41 and col. 10, lines 20 to 48 and alleges that Ishikawa et al. disclose tracking of a medical product. However, these references merely disclose the sensing of a product using a sensor so as to assure that such product is not left inside a patient. Applicant respectfully submits that scanning is not the same as tracking. The surgeon may be tracking the location of the device by originally checking in the item and noting the location of the item and then scanning the patient at the end of surgery to once again note the location of the device. However, claim 49 recites that the computer system, not the doctor, tracks the location of the medical product. Ishikawa et al. do not disclose a computer system which in any way tracks a location of a medical product.

Notwithstanding the above, claim 49 has been amended to recite that the computer system also stores the location of the medical product based on the RFID. As each item is checked in or out the location of the item is stored allowing the location of the item to be tracked over time. Applicant respectfully submits that Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track and store a location of the medical product based on the RFID, as recited in amended claim 49.

As the Final Office Action points out, Ishikawa et al. state that the surgery site may be scanned to locate the medical instrument. More specifically, Ishikawa et al. state that before closing of the patient's body, the surgical site may be scanned with a monitoring unit and that if a transponder were to respond it could be located. See col. 8, lines 32 to 34. However, Ishikawa et al. make no mention of using a computer system to store a location of the transponder for tracking purposes. Rather, a sensor is stated to be used to illicit some response from the transponder, i.e., an audible signal, so that a surgeon or nurse, for example, can note the location of the transponder and remove it from the patient. Nor are the check in or check out locations of the medical product stored for tracking purposes.

The Final Office Action further points to col. 10, lines 20 to 48 of Ishikawa et al. A first staging area 179 is stated to be used to check items into the operating room and a second staging area 183 is stated to be used to check items out of the operating room. See col. 10, lines 32 to 37. Nowhere, however, do Ishikawa et al. disclose, or even suggest, that anything other than a product identification and check in and/or check out status is stored in memory. Therefore, Ishikawa et al.

do not disclose all of the limitations of amended claim 49.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Ishikawa et al. do not disclose, or even suggest, all of the limitations of claim 49. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of claim 49 are respectfully requested.

As for claims 50 to 54, 56 to 59, 66 and 68 to 72, which ultimately depend from claim 49 and therefore include all of the limitations of claim 49, it is respectfully submitted that Ishikawa et al. do not anticipate these dependent claims for at least the same reasons provided above in support of the patentability of claim 49. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of claims 50 to 54, 56 to 59, 66 and 68 to 72 are respectfully requested.

### **III. Rejection of Claims 54 to 59, 61, 62 and 69 to 72 Under 35 U.S.C. § 103(a)**

Claims 54 to 59, 61, 62 and 69 to 72 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ishikawa et al. Applicant respectfully submits that Ishikawa et al. do not render unpatentable claims 54 to 59, 61, 62 and 69 to 72 for the following reasons.

Claims 54 to 59, 61, 62 and 69 to 72 ultimately depend from claim 49 and therefore include all of the limitations of claim 49. As indicated above, Ishikawa et al. do not disclose all of the limitations of claim 49. Specifically, Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to **track and store a location of the medical product** based on the RFID, as recited in claim 49. Therefore, Ishikawa et al. do not disclose all of the limitations of claims 54 to 59, 61, 62 and 69 to 72.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438

(Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to **track and store a location of the medical product** based on the RFID, as recited in claim 49. Therefore, Ishikawa et al. do not render obvious claims 54 to 59, 61, 62 and 69 to 72, which ultimately depend from claim 49. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 54 to 59, 61, 62 and 69 to 72 are respectfully requested.

#### **IV. Rejection of Claim 67 Under 35 U.S.C. § 103(a)**

Claim 67 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ishikawa et al. and U.S. Patent No. 6,313,747 (“Imaichi et al.”). Applicant respectfully submits that the combination of Ishikawa et al. and Imaichi et al. does not render unpatentable claim 67 for the following reasons.

Claim 67 depends from claim 49 and therefore includes all of the limitations of claim 49. Imaichi et al. purportedly relate to a resonant tag including an insulating thin film and coiled circuits made of a metal foil. Imaichi et al. do not remedy, nor are Imaichi et al. relied upon for remedying, the above detailed deficiencies of Ishikawa et al. Therefore, the combination of Ishikawa et al. and Imaichi et al. does not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to **track and store a location of the medical product** based on the RFID, as recited in claim 49. Therefore, the combination of Ishikawa et al. and Imaichi et al. does not render obvious claim 67. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection and allowance of claim 67 are respectfully requested.

#### **V. New Claim 73**

New claim 73 has been added herein. It is respectfully submitted that claim 73 adds no new matter and is fully supported by the present application, including the Specification. Applicant respectfully submits that new claim 73 is patentable over the references relied upon for at least the same reasons submitted above in support of the patentability of claim 49.

**VI. Conclusion**


It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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